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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,356	05/22/2001	Steve Tendon	ALBIHN W 3.0-410	9895

7590 09/22/2006

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EXAMINER
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LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/862,356

Applicant(s)

TENDON ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3622

### **DETAILED ACTION**

1. Claims 1-47 have been examined. Application 09/862,356 (Computer system and method for the establishment of a virtual marketplace of promotional values) has a filing date 05/22/2001.

#### ***Response to Amendment***

2. In Response to Non Final Rejection filed 12/21/2005, the Applicant filed an Amendment on 06/26/2006, which amended claims 5, 15, 28 and 47. Applicant's amendment overcame the Claim 15 objection.

#### ***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are not label by figure number and also the text in the drawings is almost impossible to read. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter

Art Unit: 3622

which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Said claims recite that “mobile communication devices associated with consumers and managing each of said M-points in a manner which relates only to each individual mobile communication device and not to a physical persona owing said mobile device”. The Applicant’s specification is not enabling in describing how mobile communications devices are associated with consumers but are also not associated with a physical persona owing said devices. Applicant’s specification is not enabling in how user’s information is kept private in mobile communication devices but also mobile communication devices are associated with individuals.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite “managing M-points in a manner which relates only to each individual mobile communication device, and not to a physical person owing said mobile communication”. Said claim is indefinite because claim 1 recites mobile device associated with individual consumers and claim 13 seems to recite that said mobile device are not associated with individual consumers. For purpose of art rejection, said limitation would be interpreted as meaning that users of communication devices would

Art Unit: 3622

need to enter some type of identification to be able to access a network and use said devices.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (US 2004/0193489) in view of Yu (US 6,684,087).

As per claims 1, 16 and 29, Boyd teaches:

A distributed computer system for the establishment of a marketplace for branded promotional values issued by at least two businesses and being awarded to at least two consumers, said distributed computer system comprising:

a persistent storage node arranged for storing data related to said promotional values (see paragraph 133), said at least two businesses and said at least two consumers (see paragraphs 102-111, 403);

an application server node for managing data stored by said persistent storage node, for executing transaction processing regarding said data, and for interfacing with said at least two businesses and said at least two consumers (see paragraphs 102-111; 403);

Art Unit: 3622

said distributed computer system being adapted for communicating with said at least two businesses and for communicating with communication devices associated with said at least two consumers (see paragraph 91 “client computer stations are personal computers with modems or network connections”; paragraph 403);

said distributed computer system being arranged to allow transactions involving said promotional values (see paragraph 399 “private label points”) between said at least two businesses and said at least two consumers, thereby providing said marketplace between said at least two businesses, and between said at least two consumers, respectively (see paragraphs 403-406). Boyd does not expressly teach that said communication device is a mobile device. However, Yu describes in the background of his invention that mobile communication devices are introduced to provide mobility and portability of the Internet, where said devices are capable of communicating via wireless data networks with the Internet. The Interactive two-way communication mobile devices includes two-way pagers, cellular phones, palm-sized computing devices and PDAs that enable users to receive, collect, analyze, review and disseminate information as they travel or move about (see Yu col 1, lines 30-45). Therefore, it would have been obvious to person of ordinary skill in the art at the time the application was made, to know that Boyd’s Internet-enable personal computers<sup>1</sup> would also include mobile communication devices, as taught by Yu in order to enable users

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<sup>1</sup> Boyd paragraphs 414-415

Art Unit: 3622

of said communication devices to receive, collect, analyze, review and disseminate information as they travel or move about.

As per claims 2 and 17, Boyd teaches:

A distributed computer system as claimed in claim 1, wherein said persistent storage node is constituted by a database server which comprises the following databases:

a device database storing identification information and data related to communication devices associated with said at least two consumers (see paragraph 414 "client computers are personal computers with modem or network connections);

a business database storing data related to said at least two businesses and a transaction database storing data related to said transactions involving said promotional values (see paragraphs 403-406). Boyd does not expressly teach that said communication device is a mobile device. However, the same argument made in claim 1 regarding this missing limitation is also made in claim 2.

As per claim 3, Boyd teaches:

A distributed computer system as claimed in claim 2, wherein said database server further comprises a promotions database storing data related to promotions performed by said businesses (see paragraphs 398-399; paragraph 406; private label programs where merchants pay Yahoo points, private label them, so they can have their own points, controlled by said merchants and run by Yahoo).

Art Unit: 3622

As per claim 4, Boyd teaches:

A distributed computer system as claimed in claim 1, wherein said application server node provides a set of core services according to which coordination and processing of said transactions, and interfacing with said persistent storage node are carried out (see paragraphs 398-399).

As per claims 5, 18 and 30, Boyd teaches:

A distributed computer system as claimed in any one of the preceding claims and being arranged in order to manage said promotional values in terms of non-zero amounts of branded M-points, where an M-point is invariably associated with the issuing business, and attributed by a point value freely determined by the corresponding issuing business (see paragraphs 403-406; 125; see paragraphs 399, 406 “merchants purchase points from Yahoo and private label them, so said merchants could have their own points, controlled by said merchants and run by Yahoo).

As per claims 6, 19 and 43, Boyd teaches:

A distributed computer system as claimed in claim 5, and being arranged for core services involving at least one of the following transactions:

an ownership transaction in which an amount of M Points is transferred (1) from the corresponding issuing business to one individual consumer's communication device (see paragraph 403 “individuals can trade, buy and sell points with other individuals); or (2) from one individual consumer's communication device to a second and distinct individual consumer's communication device (see paragraph 403); or (3) from an individual consumer's



Art Unit: 3622

communication device back to the original issuing business (see paragraphs 398; 403-406; "points are redeemed when returned to the merchant that issued them"),

a redemption transaction in which a consumer redeems an amount of M-points, and a trade transaction in which two ownership transactions are carried out concurrently (see paragraph 125, 398 and 403). Boyd fails to teach that said communication device is a mobile communication device. However, the same argument made in claim 1 regarding this missing limitation is also made in claim 6.

As per claims 7 and 21, Boyd teaches:

A distributed computer system as claimed in claim 6, wherein said ownership transaction is constituted by either a marcom transaction, during which a marketing communication message is transmitted to said communication device (see paragraph 429), or a withdraw transaction, during which an amount of M-points is returned to the corresponding said issuing business (see paragraphs 216, 398). Boyd fails to teach that said communication device is a mobile communication device. However, the same argument made in claim 1 regarding this missing limitation is also made in claim 7

As per claims 8 and 23, Boyd teaches:

A distributed computer system as claimed in claim 7, wherein said marcom transaction is constituted by either a transfer transaction during which one or more M points are transferred from an account of a first consumer to an account of a further consumer (see paragraph 193, 200 "points traded between

Art Unit: 3622

group of friends), or an award transaction during which one or more M points are awarded by a business to a communication device being associated with a consumer (see paragraphs 136, 403-406). Boyd fails to teach that said communication device is a mobile communication device. However, the same argument made in claim 1 regarding this missing limitation is also made in claim 8.

As per claims 9, 20, 22 and 44, Boyd teaches:

A distributed computer system as claimed in claim 6, wherein said trade transaction is constituted by either a morph transaction during which a consumer is allowed to convert a non-zero amount of M-points relating to one business into a non-zero amount of M-points relating to a second and distinct business (see paragraph 406 "private label program"; paragraph 134 "Yahoo points can be converted into miles for many frequent flyer programs"), and whereby the conversion ratio between the two amounts is determined automatically by said application server node depending on data from said businesses, or an exchange transaction (see paragraph 406 "exchange rate") during which a first consumer transfers a non-zero amount of M-points relating to a first business to a second and distinct consumer, said second consumer returning to said first consumer a non-zero amount of M-points relating to a second and distinct business, whereby both amounts are freely determined by respective relinquishing consumer (see paragraphs 403-406).

As per claim 10, Boyd teaches:

Art Unit: 3622

A distributed computer system as claimed in claim 5, and being arranged in order to handle promotions undertaken by businesses, and whereby each business can freely determine the start and stop time of its said promotions (see paragraph 176, 136 “specific number of points is merchant specific”; paragraph 406 “merchants could have their own points, control by said merchants”).

As per claims 11, 24, 31 and 42, Boyd teaches:

A distributed computer system as claimed in claim 5, and being arranged for managing different types of said M points for each involved said businesses, in the form of a single brand point which is directly associated with the issuing business, and attributed by a value multiplier freely determined by the corresponding issuing business (see paragraphs 399, 406; private label program where merchants purchase points from Yahoo and private label them, where said merchants own and control said points).

As per claims 12, 25 and 32, Boyd teaches:

A distributed computer system as claimed in claim 5, further being arranged for managing said M-points in the form of a one or more of promotional points each of which, in addition to being associated with the issuing business, is also associated to a specific promotion undertaken by the issuing business, and attributed by a distinct value multiplier freely determined by the corresponding issuing business (see paragraph 406 “private label program”).

As per claims 13, 26 and 33, Boyd teaches:

A distributed computer system as claimed in claim 5, and being arranged for managing each of said M-points in a manner which relates only to each

Art Unit: 3622

individual communication device, and not to a physical person owning said communication device (see paragraph 208 "Yahoo ID"). Boyd fails to teach that said communication device is a mobile communication device. However, the same argument made in claim 1 regarding this missing limitation is also made in claim 13.

As per claims 14 and 27, Boyd teaches:

A distributed computer system as claimed in claim 5, wherein said system is arranged to manage said amounts of M-points with at least one account related to each communication device and to each kind of point, and at least one account related to each business and each kind of point (see paragraphs 403-406).

As per claims 15 and 28, Boyd teaches:

A distributed computer system as claimed in claim 1, comprising a web server adapted for communicating with said communication devices, which in turn are constituted by Internet-enabled devices such as cellular mobile telephones, personal digital assistants, personal computers, telematics equipped automobiles and other so-called "smart vehicles," or yet other functionality equivalent devices (see paragraph 414 "client computer stations are personal computers"). Boyd fails to teach that said communication device is a mobile communication device. However, the same argument made in claim 1 regarding this missing limitation is also made in claim 15.

As per claim 34, Boyd teaches:

Art Unit: 3622

A method as claimed in claim 33, wherein the awarding of said M-points to said communication device comprises transmission of a marketing communication message for presentation to said consumer via said communication device (see paragraph 216). Boyd fails to teach that said communication device is a mobile communication device. However, the same argument made in claim 1 regarding this missing limitation is also made in claim 34.

As per claim 35, Boyd teaches:

A method as claimed in claim 34, wherein said transmission of a marketing communication message is invariably actuated as a result of said consumer participating in at least one predetermined point-earning opportunity and any thereof ensuing M-point transaction (see paragraph 216).

As per claim 36, Boyd teaches:

A method as claimed in claim 30, wherein each consumer's interest level in promotional offerings from each one of said at least two businesses can be inferred and determined indirectly by their M-point transaction activity (see paragraph 216).

As per claim 37, Boyd teaches:

A method as claimed in claim 36, wherein different marketing communication messages are transmitted to different communication devices depending consumer's said inferred interest level (see paragraph 216). Boyd fails to teach that said communication device is a mobile communication device.

Art Unit: 3622

However, the same argument made in claim 1 regarding this missing limitation is also made in claim 37.

As per claim 38, Boyd teaches:

A method as claimed in claim 32, and being arranged in order to handle promotions undertaken by businesses, and whereby each business can freely determine the start and stop time of its said promotions (see paragraph 176).

As per claim 39, Boyd teaches:

A method as claimed in claim 38, wherein said promotion is associated with a start point of time and a stop point of time, which together define the time period during which the promotional points associated with said promotion can be subject to any kind of M-point transactions (see paragraph 176).

As per claim 40, Boyd teaches:

A method as claimed in claim 39, wherein said promotional point can be redeemed between said start point of time and said stop point of time, but cannot be redeemed after the expiration of said stop point of time; however after the expiration of the promotional period said promotional point can yet be subject to any kind of M-point transaction except a redemption transaction (see paragraph 176).

As per claim 41, Boyd teaches:

A method as claimed in claim 40, wherein expired 35 wherein expired promotional M-points can be reinstantiated by the issuing business by re-allowing redemption transactions thereof (see paragraph 176).

As per claim 45, Boyd teaches:

Art Unit: 3622

A method as claimed in claim 44, wherein said morph transaction allows co-/cross-marketing between different businesses, said transaction being mediated by a service provider without any direct relationship between said businesses (see paragraphs 161, 162, 403-406).

As per claim 46, Boyd teaches:

A method as claimed in claim 45, wherein all compensations and charges between said businesses are handled retroactively as a percent reduction or increase on the ordinary redemption commission due to the service provider (see paragraph 398).

As per claim 47, Boyd teaches:

A method as claimed in any one of claims 30-46, wherein said M-points can be allowed to be redeemed by said consumer in exchange for said promotional values (see paragraphs 125-134).

### ***Response to Arguments***

7. Applicant's arguments filed 06/26/2006 have been fully considered but they are not persuasive. The Applicant argues that the system of claim 1 allows to easily communicate with businesses without having to locate a computer. The Examiner answers that Applicant's is arguing about limitation not stated in the claim. Claim 1 only recites a "mobile communication device". Boyd teaches a Internet-enable personal computer<sup>2</sup> and Applicant's claim 15 recites that a mobile devices are constituted by personal computers. However, because Boyd does not expressly mention the term "mobile", the Examiner is bringing the Yu

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<sup>2</sup> Boyd paragraphs 414-415

Art Unit: 3622

reference to teach that it is old and well known in the computer art at the time the application was made, to use Internet-enable mobile communication devices in order to receive, collect, analyze, review and disseminate information as users of said devices travel or move about.

The Applicant argues that Boyd does not teach “branded promotional values”. The Examiner answers that Boyd teaches private label programs, where merchants purchase points from Yahoo and private label them, so that said merchants could have their own points and control them<sup>3</sup>. Therefore, contrary to Applicant’s argument, Boyd teaches “branded points or promotional values”, as defined by Applicant’s specification.<sup>4</sup>

### ***Conclusion***

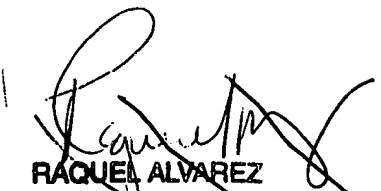
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

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<sup>3</sup> Boyd paragraphs 399 and 406

<sup>4</sup> Applicant’s specification page 23



RAQUEL ALVAREZ  
PRIMARY EXAMINER

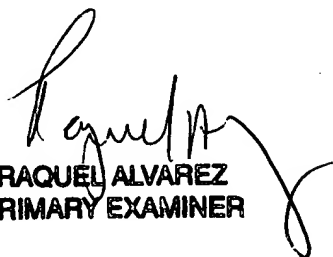


Art Unit: 3622

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DL

Daniel Lastra  
September 11, 2006

  
**RAQUEL ALVAREZ**  
**PRIMARY EXAMINER**